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	Art Unit	2623
	Examiner Name	Reuben M. Brown
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PATENTS
UV-72

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appellant : Franklin E. Boyer et al.
Application No. : 09/330,793 Confirmation No.: 9836
Filed : June 11, 1999
For : TELEVISION SYSTEM WITH AIDED USER
PROGRAM SEARCHING
Art Unit : 2623
Examiner : Reuben M. Brown

New York, New York 10036
December 4, 2007

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REPLY BRIEF

Sir:

Pursuant to 37 C.F.R. § 41.41(a), appellants are filing this Reply Brief in reply to the Examiner's Answer dated October 4, 2007 (hereinafter "the Examiner's Answer"), and in support of their appeal from the final rejection of claims 151-154, 156-159, 161-164, and 202-205 in the Office Action dated June 29, 2006. Appellants previously filed a Notice of Appeal on November 28, 2006 and an Appeal Brief on June 28, 2007 (hereinafter "Appeal Brief") in connection with this case.

I. Introduction

Appellants maintain the position that claims 151-154, 156-159, 161-164, and 202-205 of the present application are patentable in view of Ellis et al. U.S. Patent No. 5,986,650 ("Ellis"), Maissel et al. U.S. Patent Publication No. 2004/0049787 ("Maissel"), and Herz et al. U.S. Patent No. 5,758,257 ("Herz"). Appellants submit that the Examiner's Answer is insufficient as a matter of law to uphold the prior art rejections for at least the reasons set forth in appellants' Appeal Brief. Appellants have filed this Reply Brief to address comments in the October 4, 2007 Examiner's Answer and to further demonstrate the patentability of pending claims 151-154, 156-159, 161-164, and 202-205.

II. Summary of the Examiner's Answer

The Examiner's Answer maintains the § 103(a) rejection of claims 151-154, 156-159, 161-164, and 202-205 from the June 29, 2006 Office Action and restates the same grounds of rejection from that Office Action.

The Examiner's Answer also provides a "Response to Arguments" section that addresses appellants' arguments presented in appellants' Appeal Brief.

III. Summary of the Appellants' Reply

Appellants' Appeal Brief fully addresses the grounds of rejection stated in the June 29, 2006 Office Action.

This Reply Brief addresses the Examiner's comments on appellants' arguments contained in the Appeal Brief.

Appellants submit that the Board should find the rejections of claims 151-154, 156-159, 161-164, and 202-205 to be in error and should reverse the Examiner.

IV. Argument of Independent Claims
151, 156, 161, and 202

A. The Examiner's Combination Still Fails to
Disclose Each and Every Claim Limitation

Appellants submit that the Examiner's Answer is insufficient to uphold the 35 U.S.C. § 103(a) rejections of claims 151-154, 156-159, 161-164, and 202-205 for at least the reason that the Examiner has still failed to demonstrate that the combination of Ellis, Maissel, and Herz discloses the claimed feature of "limiting which program listings are displayed in the display region based only on various program attributes of the current program" (independent claims 151, 156, 161 and 202).

In the Examiner's Answer, the Examiner disagrees with appellants' argument that Maissel does not show or

suggest the above-mentioned feature of appellants' claims. In the first paragraph of page 10 of the Examiner's Answer, the Examiner states various passages of Maissel that detail how Maissel provides customization of an electronic program guide by an intelligent agent. Then, in the second paragraph of page 10 of the Examiner's answer, the Examiner purportedly quotes appellants' Appeal Brief and states:

[T]hat by the statement; "the possibility that the claimed limitation (i.e., currently displayed program) falls within the range, i.e., reads on Maissel", appellant admits that Maissel provides a functional equivalent of the claimed limitation.

As an initial matter, nowhere in appellants' Appeal Brief do appellants make such a statement. The direct quote from appellants' Appeal Brief is:

The possibility that the range of time the viewer watches a current program may fall within the range of "a few minutes" is mere happenstance, and limiting to a currently displayed program is not what is being taught by Maissel.

Second, appellants respectfully submit that the Examiner is misconstruing appellants' argument that Maissel's disclosure of generating a user profile for "as short as a few minutes" does not show or suggest "limiting which program listings are displayed in the display region based only on various program attributes of the current program".

Contrary to the Examiner's assertion, appellants' argument is not an admission that Maissel provides a

functional equivalent of the claimed limitation. Rather, appellants' argument is that Maissel's disclosure of generating a user profile for "as short as a few minutes" is **not** functionally equivalent to appellants' "limiting which program listings are displayed in the display region based **only** on various program attributes of the current program". This passage of Maissel merely says that Maissel may build a viewer preference profile based on a few minutes of time. Nowhere does Maissel show or suggest that a preference profile built over a few minutes of time would be the **only** factor in limiting which program listings are displayed.

The Examiner argues that Maissel can limit program listings based only on the current program because (1) Maissel can eliminate old viewer preference profile information or reset the profile upon receipt of a signal from the TV network (see Examiner's Answer, page 11, first paragraph); and (2) a user of Maissel's system can turn off or on the collection of profile information (see Examiner's Answer, page 11, second paragraph). In following the method outlined in the Examiner's argument, a user would have take a multitude of steps. For example, for each and every current program the user would have to:

1. Turn off the collection of viewer preference profile information;

2. Tune to the desired program;

3. Set the collection time period of the viewer preference profile information to the minimum collection period of "a few minutes".

4. Turn on the collection of viewer preference profile information, which will adversely affect the program guide presented (e.g., the program guide will initially be empty until the user watches programs).

5. Watch the desired program for "a few minutes" while simultaneously waiting for the system to receive a signal from the television network to erase old information from the viewer preference profile or reset the viewer preference profile. The user must be sure that his period is sufficiently long as Maissel does not permit the viewer to manually reset the viewer preference profile.

6. Finally, the user must be sure not to change the channel or interact with the EPG - otherwise, they will influence the viewer preference profile and the information presented in the EPG will not be based only on the current program.

After all of these steps, the Examiner argues that Maissel might provide information to reflect only the

current program that the user is watching. However, there would be no way to verify this, as Maissel does not provide any way to directly control the profile creation process or verify the content of the profile. Further, operating Maissel in this manner would substantially hamper the overall system performance, as the user would have to perform the steps in their strict order in hopes of achieving the desired result. Finally, it would be logistically impractical for the system to perform this routine for more than one program at a time. Accordingly, appellants' claims patentably improve on the functionality of Maissel.

As demonstrated above, the Examiner's arguments that specific portions of Maissel enable Maissel's system to be functionally equivalent to appellant's claims are unfounded when looking at Maissel alone. Appellants remind the Examiner that in an obviousness rejection

[i]t is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art.

W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (emphasis added). Appellants submit that

the Examiner has failed to fulfill this requirement because he is reading Maissel entirely in light of appellants' claims. Accordingly, the Examiner's combination of Ellis, Maissel, and Herz is insufficient as a matter of law.

Further, by arguing that Maissel's disclosure of generating a user profile for "as short as a few minutes" is equivalent to appellants' claim limitation of "limiting which program listings are displayed in the display region based *only* on various program attributes of the current program", the Examiner is (1) impermissibly broadening the disclosure of Maissel; and (2) improperly relying on equivalence as a rationale supporting an obviousness rejection.

In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Scott*, 323 F.2d 1016, 139 USPQ 297 (CCPA 1963). The Examiner asserts that "Maissel is aware of the benefits of a more narrow and limited period of accumulating history" and that one of ordinary skill in the art would have recognized this as equivalent to appellants' claim limitation (See Examiner's Answer, pgs 10 and 11).

Contrary to the Examiner's assertion, Maissel does not demonstrate any "awareness" to apply the limited period of "accumulating history" as the *only* factor in limiting which program listings are displayed. In fact, Maissel's monitoring of recent viewing history is very different than monitoring which program a user is currently watching, as a user may watch several programs and interact with the EPG in any number of ways within the span of a "few minutes". Accordingly, the Examiner is looking to appellants' disclosure in claiming that the disclosure of Maissel shows appellants' claims. For at least this reason, a *prima facie* case of obviousness has not been made.

B. The Examiner's Comments Fail to Address That Maissel Leads Away from Appellants' Claims

In the Examiner's answer, the Examiner disagrees with appellants' argument that Maissel leads away from appellants' claims and maintains that

It would have been obvious for one of ordinary skill in the art at the time the invention was made, to modify Ellis with teachings of Maissel . . . to more accurately filter the EPG.
(Examiner's Answer, page 12)

As described in section vii.A.2 of appellants' Appeal Brief, the question is not whether one skilled in art would modify Ellis with Maissel to more accurately filter the EPG, but whether one would make such a combination in order

to limit displayed listings based only on the currently displayed program. Appellants' claims have nothing to do with accurately filtering program guide listings, but rather provide specific and useful additional information to the user. Further, appellants maintain that one skilled in the art would not make such a combination, as portions of Maissel teach storing program characteristics over extended periods of time in order to build a viewer preference profile. Thus, Maissel leads away from appellants' claimed approach, not toward it. Accordingly, a *prima facie* case of obviousness has not been made.

C. Despite the Examiner's Arguments, Herz is Not in the Same Field of Endeavor as Appellants' Invention

In the Examiner's Answer, the Examiner asserts that contrary to appellants' argument Herz is in the same field of endeavor as appellants' invention because both Herz and the appellants' invention "provide customized lists of programs to the customer based on the viewing history/profile of the customer" (see Office Action, page 13). In addition, the Examiner notes that Herz discloses that "virtual channels may be delivered to the customer in at least several ways; highlighting directly on the EPG or displayed to the customer's screen as recommended program

selections." Appellants respectfully submit that regardless of the fact that Herz highlights "virtual channels" of recommended programming on an EPG, Herz is not in the same field of endeavor as appellants' invention.

Even though the Examiner construes Herz's highlighting on an EPG as program listings, Herz still does not provide related program listings during a browse of TV channels based on a limiting factor. Rather, Herz provides highlighting of "virtual channels" of recommended programming that are restricted to the custom programming delivered to the user. In other words, Herz's virtual channels of custom programming are the primary result of Herz's operation, and the so-called "listings" are provided merely to describe the virtual channels. The custom programming delivered to the user by the virtual channels is restricted in the sense that it is a subset of the programming available to the user. In contrast, appellants' claimed invention provides additional related information to the user during their unrestricted browse of TV programming. Thus, unlike appellants' claimed invention, Herz's so-called "listings" are neither immediately customized based on the present actions of the user, nor are they customized based on the full range of programming presently available to the user. Accordingly,

appellant respectfully submits that such distinctions show that Herz and appellants' claimed invention are not in the same field of endeavor.

Further, appellants maintain that Herz does not solve the same problem as appellants' claimed invention. As described above, Herz is primarily concerned with providing customized programming to the user based, at least in part, on the past viewing history of the customer. The schedule for this customized programming may be highlighted on an EPG. Appellants' claimed invention solves the problem of providing a more efficient and immediate customized browse feature. Delivering information on a customized subset of video programs is completely different than providing additional information while browsing television - each problem would bring different challenges and thus lead to different solutions. Thus, Herz solves a different problem than appellants' claimed invention and is not reasonably pertinent to appellants' invention.

Because Herz is neither in the same field of endeavor nor reasonably pertinent to appellants' claims, appellants respectfully submit that Herz would not have logically commended itself to an inventor's attention when considering the problem of providing related information

during a browse of television channels. *See generally In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992). Accordingly, appellants respectfully submit that Herz is not pertinent, and the Examiner's combination of Ellis, Maissel, and Herz is insufficient as a matter of law.

V. Argument of Dependent Claims
154, 159, 164, and 205

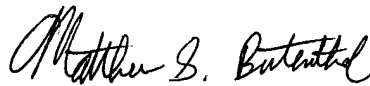
Appellants note that the Examiner did not address appellants' arguments with respect to dependent claims 154, 159, 164, and 205. Appellants maintain their arguments with respect to dependent claims 154, 159, 164, and 205, and respectfully request that the Board should reverse the obviousness rejection of these claims.

VI. Conclusion

For at least the reasons set forth above, appellants respectfully submit that claims 151-154, 156-159, 161-164, and 202-205 are in condition for allowance.

The Examiner's rejections of these claims should be reversed.

Respectfully submitted,



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